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REMARKS

The Examiner acknowledged receipt of the December 17, 2001 Preliminary Amendment filed in the captioned application.

The specification was amended by having a new paragraph added beginning at page 1, line 4, to reference the parent case.

The specification was also amended at page 1, line 26, to correct a typographical error.

It is submitted that no new matter has been introduced by the foregoing amendments. Approval and entry of the amendments is respectfully solicited

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made."

Anticipation Rejection

Claims 1-6 were rejected under 35 USC §102(b) as anticipated by Mothes *et al.*, US Patent No. 5,961,707 ("Mothes"). (March 19, 2002 Office Action ("OA") at 2.)

For the reasons set forth below, the rejection, respectfully is traversed.

Mothes discloses "granules having a relatively high content of ethanol (below 'alcohol') and a process for the preparation of alcohol containing granules by fluidized-bed spray granulation." (Col. 1, lns. 6-9.)

In making the rejection, the Examiner contended that Mothes "teaches alcohol-containing granules coated with waxes, cellulose, gelatin, lactose, or starches. (OA at 2.) The Examiner also asserted that "[t]he alcohol-containing granules can be incorporated into dry soups, sauces, desserts, and beverages." The Examiner then asserted that "[a]lthough Mothes is silent as to the teaching of the indented use being claimed.... the intended us[e] is inherent since Mothes obtains the same result from the use of encapsulated alcohol as additives useful in dry soups, sauces, desserts, and beverages." The Examiner also admitted that "Mothes is silent as to the teaching of long-chain alcohol." (OA at 3.)

At the outset, the Examiner acknowledged receipt of the 12/17/01 Preliminary Amendment. However, the Examiner rejected claim 1. The Examiner is reminded that claim 1 was canceled in the 12/17/01 Preliminary Amendment. Accordingly, the rejection is moot as it pertains to claim 1 and withdrawal thereof is respectfully requested.

As is well settled, anticipation requires "identity of invention." Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim.

In a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. Moreover, it is incumbent upon the Examiner to *identify wherein each and every facet* of the claimed invention is disclosed in the applied reference. The Examiner is required to point to the disclosure in the reference "*by page and line*" upon which the claim allegedly reads.

The rejection fails to identify where in Mothes each and every element of the rejected claims is shown. The pending claims require, among other things, an alcohol having an average chain length of from about $C_{20} - C_{26}$. The Examiner **admitted** that Mothes "**is silent as to the teaching of long-chain alcohol**". To the extent the Examiner equates an alcohol having an average chain length of from about $C_{20} - C_{26}$ with a long chain alcohol, then the Examiner admitted that Mothes does not disclose each and every element of the claimed invention. This is insufficient as a matter of law to support a conclusion of anticipation, and for this reason, the rejection should be withdrawn.

Claims 1-6 were rejected under 35 USC §102(b) as anticipated by Mothes *et al.*, US Patent No. 5,961,707 ("Mothes"). (March 19, 2002 Office Action ("OA") at 2.)

For the reasons set forth below, the rejection respectfully is traversed.

Cain discloses fat-continuous emulsions of fat and water having a fat and an emulsifier system. (p. 2, lns. 26-29.) The emulsifier system was disclosed as being a blend of components, with emulsifying properties, having components (A), (B), and (C). (p. 2, lns. 29-32.) A was disclose as being a partial glyceride, containing at least one fatty acid residue with at least 2 carbon atoms. B was disclosed as being a phospholipid. (p. 3, ln. 1.) C was disclosed as being a long chain alcohol having at least 20 carbon atoms in the carbon chain. (p. 3, lns. 2-3.) Cain disclosed that component (C) is present in a number of natural products such as wheatgerm-wax, carnauga-wax, rice bran wax and sugar cane wax. (p. 3, lns. 8-10.)

At the outset, the Examiner acknowledged receipt of the 12/17/01 Preliminary Amendment. However, the Examiner rejected claim 1. The Examiner is reminded that claim 1 was canceled in the 12/17/01 Preliminary Amendment. Accordingly, the rejection is moot as it pertains to claim 1 and withdrawal thereof is respectfully requested.

As is well settled, anticipation requires "identity of invention." Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim.

In a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. Moreover, it is incumbent upon the Examiner to *identify wherein each and every facet* of the claimed invention is disclosed in the applied reference. The Examiner is required to point to the disclosure in the reference "*by page and line*" upon which the claim allegedly reads.

It is respectfully submitted that it is believed that Cain does not disclose as much as the Examiner asserted. In particular, the Examiner asserted that "Cain teaches .... long chain alcohol encapsulated in wax." However, such disclosure cannot be located in Cain. It has been found that Cain discloses that the long chain alcohol was present in a number of natural products. This, however, is not believed that the disclosure of a source of a component is a disclosure of an encapsulated component. Based upon this understanding, the rejection is improper and should be withdrawn.

Obviousness Rejection

Claims 1-6 were rejected under 35 USC §103(a) as being unpatentable over Mothes. (OA at 3.)

For the reasons set forth below the rejection, respectfully is traversed.

Mothes' disclosure set forth above is incorporated herein by reference.

In making the rejection, the Examiner asserted that Mothes is relied upon for the reasons stated above. (OA at 3.) The Examiner acknowledged, however, that Mothes differs from the presently claimed invention in that "Mothes is silent as to the teaching of long-chain alcohol."

The Examiner merely concluded that "it would have been obvious for one of ordinary skill in this art to use any alcohol, which will include long-chain alcohol, fatty alcohol, or aliphatic alcohol."

At the outset, the Examiner acknowledged receipt of the 12/17/01 Preliminary Amendment. However, the Examiner rejected claim 1. The Examiner is reminded that claim 1 was canceled in the 12/17/01 Preliminary Amendment. Accordingly, the rejection is moot as it pertains to claim 1 and withdrawal thereof is respectfully requested.

Obviousness cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, "cold hard facts." When a conclusion of obviousness is not based upon facts, it cannot stand.

Mothes defined ethanol as being the alcohol that was the subject of the document. (Col. 1, lns. 6-9.) As admitted by the Examiner, Mothes does not disclose the claimed long chain alcohol. The Examiner did not provide any evidence that would provide one of ordinary skill in the art with any expectation of success. The record contains no evidence of the equivalence between ethanol and the long chain alcohol affirmatively required in the claims of the captioned application.

"Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor.

Because the rejection fails to satisfy the burden placed on the Examiner, the rejection is improper and should be removed.

Claims 1-8 and were rejected under 35 USC §103(a) as being unpatentable over Mothes in view of Cain. (OA at 3.)

For the reasons set forth below, the rejection respectfully is traversed.

Mothes' disclosure set forth above is incorporated herein by reference.

Cain's disclosure set forth above is incorporated herein by reference

In making the rejection, the Examiner asserted that Mothes is relied upon for the reasons stated above. (OA at 3.) The Examiner acknowledged, however, that Mothes differs from the presently claimed invention in that "Mothes is silent as to the teaching of long-chain alcohol."

To fill the acknowledged gap, the Examiner relied on Cain "for the reason stated above." (OA at 3.) The Examiner asserted that "Cain also teaches long-chain alcohol incorporated in food products, and can be used to provide simultaneously cholesterol lowering properties."

The Examiner then concluded that "it would have been prima facie obvious for one of ordinary skill in the art to modify Mothes' alcohol-encapsulated granules using the long chain alcohol in view of the teaching of Cain.

At the outset, the Examiner acknowledged receipt of the 12/17/01 Preliminary Amendment. However, the Examiner rejected claim 1. The Examiner is reminded that claim 1 was canceled in the 12/17/01 Preliminary Amendment. Accordingly, the rejection is moot as it pertains to claim 1 and withdrawal thereof is respectfully requested.

Mothes defined ethanol as being the alcohol that was the subject of the document. (Col. 1, lns. 6-9.) As admitted by the Examiner, Mothes does not disclose the claimed long chain alcohol. Cain discloses long chain alcohols in a fat-continuous emulsion. The Examiner did not provide any evidence that would provide one of ordinary skill in the art with any expectation of success in combining the two references. The record contains no evidence of the equivalence between ethanol and the long chain alcohol affirmatively required in the claims of the captioned application. Nor has the Examiner provided any evidence that the disclosure of fat emulsions could be combined with a disclosure of ethanol-containing granules.

"Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor.

Because the rejection fails to satisfy the burden placed on the Examiner, the rejection is improper and should be removed.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections, and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

The following paragraph was added:

The paragraph beginning on page 1, line 4 before "This application is being . . .":

-- This application is a divisional of prior application no. 09/461,592, filed December 15, 1999, now issued US Patent No. 6,355,274 B1 issued March 12, 2002. --

The paragraph beginning at page 1, line 22, was replaced with the following rewritten paragraph:

--Incorporation of policosanol into high fat or fat-continuous emulsion systems such margarine and margarine spreads is complicated by the functional properties of policosanol. In particular, incorporation of policosanol into a margarine oil system containing a diglyceride and a phospholipid causes an increase in the hardness of a margarine type product as disclosed in WO 98/47385. In addition, EP 09091804 discloses that the incorporation of a natural long chain alcohol in a fat continuous system reduces the viscosity and yield values of confectionery products.--